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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/702,132      | 11/05/2003  | Dennis D. Bicker     | 1033-SS00355        | 6845             |

34456 7590 12/02/2005

TOLER & LARSON & ABEL L.L.P.  
5000 PLAZA ON THE LAKE STE 265  
AUSTIN, TX 78746

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| EXAMINER |
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DESIR, PIERRE LOUIS

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| ART UNIT | PAPER NUMBER |
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2681

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,132

Applicant(s)

BICKER ET AL.

Examiner

Pierre-Louis Desir

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments with respect to claims 1, 8, and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 11/18/2005 has been received by the office. However, at the time of the completion of this Office Action (11/27/2005), The IDS has not been scanned into the system. Accordingly, the information disclosure statement is not being considered. However, if the submission is in compliance with the provisions of 37 CFR 1.97, the IDS will be considered.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-9, 11-13, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore (Pub. No. U.S. 2003/0039242), in view of Ishidoshiro (Pub. No. U.S. 2004/0066776).

Regarding claim 1, Moore discloses a method of forwarding a call from a mobile phone, the method comprising: determining that the mobile phone is within range of a wireless local

area network base station with voice over internet protocol capability (i.e., the mobile handset is enabled to determine whether it is within range of the local network) (see page 2, paragraph 29 lines 9-10); receiving an internet protocol address (see page 2, paragraph 32, and page 3 paragraphs 39-40).

Although Moore discloses a method comprising receiving an Internet protocol address (see page 2, paragraph 32, and page 3 paragraphs 39-40), and sending a call forwarding message from the mobile phone to a remote cellular network element of a wide area cellular network (see page 2, paragraph 32, and page 3 paragraph 39), Moore does not specifically (although being obvious) a method comprising receiving an Internet protocol address associated with the wireless local area network base station, nor does he specifically disclose sending a call forwarding message which includes the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network.

However, Ishidoshiro discloses a method comprising receiving an Internet protocol address associated with the wireless local area network base station (i.e., in response to input of a linkage request, the wireless LAN base station allocates an IP address to the radio IP telephone set) (see pages 3-4, paragraphs, 33, 38-40) and sending a message which includes the internet protocol address from the mobile phone to a remote cellular network element of a wide area cellular network (i.e., the radio IP telephone set notifies the wireless LAN base station of a terminal ID, which includes IP address, a MAC address, and a telephone number. The wireless LAN base station sends the terminal ID to the gatekeeper) (see pages 3-4, paragraph 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moore with the teachings as described by Ishidoshiro to

arrive at the claimed invention. A motivation for doing so would have been to ensure proper access to the network.

Regarding claim 2, Moore discloses a method (see claim 1 rejection), wherein the cellular network redirects a call destined to the mobile phone to the wireless local area network base station for communication with the mobile phone using the voice over Internet protocol (i.e., the mobile handset sends a command to the mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway via the VoIP telephone network) (see page 3, paragraphs 34, and 39).

Regarding claim 5, Moore discloses a method (see claim 1 rejection), further comprising determining that the mobile phone has moved out of range of the wireless local area network base station and sending a message to the cellular network element to cancel call forwarding to the wireless local area network base station (i.e., the handset is enabled to determine whether it is within range of the local network. And, the forwarding of telephone calls may be disabled when the handset is outside the range of the local network) (see page 2, paragraphs 29, and 30).

Regarding claim 6, Moore discloses a method (see claim 1 rejection), wherein the wide area cellular network sends a call directly to the mobile phone over the cellular spectrum after the mobile phone has moved out of range of the wireless local area network base station (i.e., if the handset is outside of the range of the local network, data traffic may be routed to and from the handset via the mobile telephone network) (see page 2, paragraph 29, lines 13-15).

Regarding claim 7, Moore discloses a method (see claim 2 rejection), wherein the mobile phone and the wireless local area network base station communicate bidirectionally using the voice over Internet protocol (i.e., a VoIP gateway for the VoIP telephone network. A cable

modem allows communication between the mobile handset and the VoIP telephone network. Also, data traffic may be routed to and from the handset via the VoIP telephone network) (see page 2, paragraph 29).

Regarding claim 8, Moore discloses a method of communicating from a wireless local area base station to a mobile phone (see abstract), the method comprising: determining that the mobile phone is within range of the wireless local area network base station, the wireless local area network base station having voice over internet protocol communications capability (i.e., the mobile handset is enabled to determine whether it is within range of the local network) (see page 2, paragraph 29 lines 9-10).

Although Moore discloses a method comprising retrieving an internet protocol address (see paragraphs 39-40), and sending the internet protocol address (see page 2, paragraphs 32, 37, 39-40, 42), Moore does not specifically disclose a method comprising retrieving an internet protocol address and an optional port number associated with the wireless local area network base station from a memory and sending the internet protocol address and optional port number to the mobile phone over a wireless fidelity communication link to the mobile phone.

However, Ishidoshiro discloses a method comprising retrieving an internet protocol address and an optional port number (base station ID) associated with the wireless local area network base station from a memory (see page 3, paragraphs, 33, 38-40) and sending the internet protocol address and optional port number to the mobile phone over a wireless fidelity communication link to the mobile phone (see pages 3-4, paragraph 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Moore with the teachings as described by Ishidoshiro to

arrive at the claimed invention. A motivation for doing so would have been to ensure proper access to the network.

Regarding claim 9, Moore discloses a method (see claim 8 rejection), further comprising receiving a call from a wide area network, the call directed to the mobile phone at the internet protocol address and the optional port number of the wireless local area network base station VoIP provider (i.e., the mobile handset sends a command to the mobile telephone network instructing the mobile telephone network to forward incoming telephone calls to a telephone number of the VoIP gateway via the VoIP telephone network) (see page 3, paragraph 34, lines 3-8. Also refer to Ishidoshiro paragraphs 39-40, and claim 8 rejection as related to the combination).

Regarding claim 11, Moore discloses a method (see claims 8, 9 rejections), wherein the wide area network includes a high speed wired communication channel (see page 2, paragraph 30).

Regarding claim 12, Moore discloses a method (see claim 9 rejection), wherein the high speed wired communication channel is a digital subscriber line connection (i.e., Broadband connection) (see page 3, paragraph 38).

Regarding claim 13, Moore discloses a method (see claims 8 rejection), further comprising establishing a bidirectional communication path between the wireless local area network base station and the mobile phone and communicating using voice over internet protocol over the bidirectional communication path (i.e., a VoIP gateway for the VoIP telephone network. A cable modem allows communication between the mobile handset and the VoIP

telephone network. Also, data traffic may be routed to and from the handset via the VoIP telephone network) (see page 2, paragraph 29).

Regarding claim 19, Moore discloses a method (see claim 2 rejection) wherein the call destined to the mobile phone is communicated between the remote cellular network element and the wireless local area network base station without utilizing a public switched telephone network (i.e., the mobile telephone network 30 and the VoIP network 25 may both be configured to route telephony data traffic to the PSTN network 40 and IP data traffic to the IP network 50) (see paragraph 52. Also refer to Ishidoshiro paragraphs 39-40, and claim 8 rejection as related to the combination).

Regarding claim 20, Moore discloses a method (see claim 1 rejection) wherein the internet protocol address is received at the mobile phone from the wireless local area network base station via a wireless connection (see page 2, paragraphs 32, 37, 39-40, 42. Also refer to Ishidoshiro paragraphs 38-40, and claim 8 rejection as related to the combination).

Regarding claim 21, Moore discloses a method (see claim 8 rejection) wherein sending the internet protocol address and the optional port number comprises sending the internet protocol address and the optional port number from the wireless local area network base station to the mobile phone (see page 2, paragraphs 32, 37, 39-40, 42. Also refer to Ishidoshiro paragraphs 39-40, and claim 8 rejection as related to the combination).

5. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moore and Ishidoshiro, in further view of Reding et al. (Reding), Pub. No. 2004/0213212.



Regarding claim 3, Moore and Ishidoshiro disclose a method as described above (see claim 1 rejection).

Although Moore and Ishidoshiro disclose a method as described, the combination does not specifically disclose a method, wherein the mobile phone determines that it is in range of the wireless local area network by receiving a message in accordance with the 802.11 communication protocol.

However, Reding discloses a method for call forwarding (see abstract), in which the system is capable of receiving an indication, which indicates that a first wireless device has entered or left the vicinity or range of a second wireless device, wherein the indication may be accomplished by using a protocol such as the IEEE 802.11(b).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings, which are analogous, to arrive at the claimed invention. A motivation for doing so would have been to allow wireless comparability comparable to Ethernet.

Regarding claim 10, Moore and Ishidoshiro disclose a method as disclosed above (see claim 9 rejection).

Although Moore and Ishidoshiro disclose a method as described above, the combination does not specifically disclose a method, wherein the wide area network is a distributed computer network.

However, Reding discloses a method of communicating from a wireless local area base station to a mobile phone, wherein the wide area network is a distributed computer network (i.e.,

a network which consist of clients and servers connected in such a way that any system can potentially communicate with any other system) (see page 2, paragraph 25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings as disclosed by Moore and Ishidoshiro with the teachings as disclosed by Reding to arrive at the claimed invention. A motivation to do so would have been to distribute processing to inexpensive system, and to relieve servers of many tasks.

6. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moore and Ishidoshiro, in further view of Shostak, Pub. No. US 20040127241

Moore and Ishidoshiro disclose a method as described above (see claim 1 rejection).

Although the combination discloses a method wherein the handset may dynamically be assigned a new IP address on an IP subnet of the voice IP gateway (see page 3 paragraph 40), the combination does not specifically disclose a method, wherein the Internet protocol address is communicated to the mobile phone using the dynamic host configuration protocol.

However, Shostak discloses a method wherein IP addresses are assigned dynamically through the customer's DHCP server (see paragraph 84).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation for doing so would have been to reduce the work necessary to administer an IP network, as related to the distribution of IP addresses.

7. Claims 14-15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reding in view of Moore and Ishidoshiro.

Regarding claim 14, Reding discloses a mobile phone comprising: a housing (see fig. 6-8); an antenna attached to the housing (see fig. 6-8); a wide area cellular communications module disposed within the housing; a wide area cellular communications module having a cellular interface to communicate with a remote wide area cellular network (i.e., transceiver) (see page 2, paragraph 26; and page 8, paragraphs 88 and 89); and a short-range wireless local area network module disposed within the housing, the short-range wireless local area network module having a wireless interface to communicate with a wireless local area network having voice over internet protocol communications capability (see page 8 paragraph 88).

Although Reding discloses a mobile phone as described above, Reding does not specifically disclose a mobile phone, wherein an internet protocol address received by the mobile phone from a wireless local area network is stored in the memory, and wherein the wide area cellular communication module formulates a call forwarding message that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network.

However, Moore discloses a disclose a mobile phone (i.e. mobile handset), wherein an internet protocol address received by the mobile phone from a wireless local area network is stored (i.e., the handset 10 may dynamically assigned a new IP address on an IP subnet of the VoIP gateway 20. One skilled in the art would immediately envision that the new IP address, which is assigned to the handset is stored in the inherent memory of the handset) (see paragraph 40).

Ishidoshiro discloses a handset wherein a message is formulated that includes the internet protocol address, the call forwarding message to be communicated to the remote wide area cellular network (see pages 3-4, paragraphs 38-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so would have been to insure the authentication of the communication process.

Regarding claim 15, Reding discloses a mobile phone (see claim 14 rejection), wherein the wide area cellular communications module and the short-range wireless local area network module are computer software modules integrated within a digital processor device (i.e., Bluetooth-enabled device) (see page 8, paragraph 89).

Regarding claim 18, Reding discloses a mobile phone as described above (see claim 15 rejection).

Although Reding discloses a mobile phone as described above, Reding fails to specifically disclose a mobile phone device, wherein an internet protocol address received by the mobile phone from a wireless local area network is stored, and wherein the wide area cellular communication module formulates a message to cancel the previously communicated call forwarding message to be sent to the remote wide area cellular network.

However, Moore discloses mobile phone device, wherein the wide area cellular communication module formulates a message to cancel the previously communicated call forwarding message to be sent to the remote wide area cellular network (i.e., the handset is enabled to determine whether it is within range of the local network. And, the forwarding of

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telephone calls may be disabled when the handset is outside the range of the local network) (see claim 1 rejection, and paragraphs 29-30, 39-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine both teachings to arrive at the claimed invention. A motivation to do so would have been to insure the authentication of the communication process.

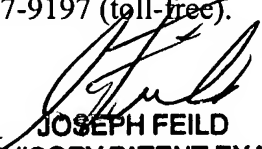
### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre-Louis Desir whose telephone number is (571) 272-779. The examiner can normally be reached on Monday-Friday 8:00AM- 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Pierre-Louis Desir  
AU 2681

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER